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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,923	02/05/2002	Laszlo Papai	TCP:104 US	9881
7590	04/01/2004		EXAMINER	
Howard M. Ellis Simpson, Simpson & Snyder, PLLC 5555 Main Street Williamsville, NY 14221			SCHILLING, RICHARD L.	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 04/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071923

Applicant(s)

Papai

Examiner

R L Schilling

Group Art Unit

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— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 1-12-04
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-19 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-19 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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1. Claims 1-19 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rationale of this rejection is set forth in paragraph 2 of the last Office action, filed September 3, 2003, incorporated herein by reference. The argument contained in the affidavit under 37 CFR 1.132 that development performance refers to the Kodak C-41 process that is known in the art is unconvincing. Applicant's specification does not define satisfactory development performance relative to any specific processing method including C-41. Also, how to measure maximum and minimum density of processed color photographic film is well known in the art. However, what final results are considered to be satisfactory or unsatisfactory is still subjective to one skilled in the art and is not set forth by definite values in the specification. The Kodak article cited in the affidavit does not set forth an explicit definition of "satisfactory developer performance"; and applicant's specification does not refer to explicit tolerances set forth in the Kodak article or any other color development process, e.g. by Fuji or Agfa, to be considered satisfactory or unsatisfactory. The term "satisfactory developer performance" is subjective, broad and indefinite without a definite test in the specification with defined results that are

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considered to be satisfactory. One skilled in the art would not know from applicants' specification what specific processing is intended to test for satisfactory results and which results, e.g. maximum or minimum density, would be considered to be satisfactory.

2. Claims 1, 2, 5, 7, 11, 16, 18 and 19 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hashimoto et al. for the same reasons as set forth in item No. 3 of the last Office action.

3. Claims 1-5, 7, 11, 16, 18 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashimoto et al. for the same reasons as set forth in item No. 3 of the last Office action. Applicant's argument in regard to the rejections under 35 U.S.C. § 102 and 103 using Hashimoto et al. that Hashimoto et al. does not set forth a developing solution but rather a slurry is unconvincing. The instant claims do not require that the color developing agent and SEHA be in solution with water. Also, a solution cannot comprise a multiphase concentrate since a solution is one phase. To overcome Hashimoto et al., claims 1 and 5 should be directed to a composition comprising a solution of water, the color developer and SEHA. Hashimoto et al. discloses a solution of water and water soluble components, such as sodium sulfite and the water soluble polymers, and further

components of particles of color developer and SEHA. Solid particles are included within the scope of the instant claims as in dependent claims 10 and 11. Claims 6 and 17 requiring a monophasic concentrate solution were not included in this rejection. Applicant's argument that Hashimoto et al. is not concerned with satisfactory development performance because all are the properties of the color image were not tested is unconvincing. Hashimoto et al. disclose improved photographic properties so that the results are at least satisfactory if not improved. Applicant correctly points out that H-11 of Hashimoto et al. does not have sulfo groups. The rejections incorrectly state that H-11 was the illustrated formula for SEHA used in the working Examples of Hashimoto while the correct illustrated compound is H-7 set forth in Hashimoto et al. Compound H-7 does not have a synthesis example set forth in Hashimoto et al. The rejection over Tappe et al. '703 has been overcome by the affidavit under 37 CFR 1.131. Ishikawa et al. '520 and Ishikawa et al. '930 are also removed as available references by the affidavit under 37 CFR 1.131.

5. Claims 1-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Darmon et al. '687 and Papai in view of Burns et al. and Hashimoto et al. further in view of Ishikawa et al. '697 and Marrese et al. Darmon et al.

(see particularly column 3, lines 35-53; column 1, lines 40-55; Example 1; column 5, line 5 - column 6, line 75) and Papai (see particularly column 2, lines 30-65; column 5, line 58 - column 6, line 20; column 9, lines 31-53; column 9, lines 3-15; Examples 1 and 2) disclose liquid concentrated color developer replenishing compositions comprising color developing agents and preservatives or antioxidants for the color developing agents to extend shelf life including alkyl hydroxylamines. Papai discloses multiphase systems comprising caprolactam organic solvent. Both Darmon et al. and Papai also disclose the use of buffers and the making of concentrates including the step of removing precipitates, e.g. sodium sulfite. Darmon et al. and Papai disclose the use of dialkyl hydroxylamine preservatives for color developing agents; and Darmon et al. specifically incorporates Burns et al. by reference as disclosing suitable hydroxylamine antioxidants. Burns et al. (column 1, line 40 - column 2, line 15; column 4, lines 43-52; Example 2) discloses SEHA as a hydroxylamine antioxidant for use in color developing solutions. Papai and Darmon do not specifically disclose the use of SEHA as antioxidants in their working Examples but rather use diethyl hydroxylamines in their working Examples. However, Hashimoto et al. (see particularly Example 2) discloses the use of SEHA as an antioxidant in concentrated color developing solutions for color

developing agent CD-4 as set forth in the instant claims as well as other known color developing agents wherein SEHA preserves the color developing agent and is the only hydroxylamine preservative used in the working Examples. Ishikawa et al. '697 (see particularly column 7, line 64 - column 8, line 64; column 9, lines 15-45; Examples 1 and 2) discloses color developing solutions and color developing solution replenishers comprising color developing agents, including CD-4, and preservatives which are preferably hydroxylamines. Among the disclosed hydroxylamines, SEHA hydroxylamines are disclosed as being preferred. SEHA hydroxylamines are also disclosed in Examples 1 and 2 in color developing agents as preservatives in combination with CD-4 color developing agents. Since Darmon et al. and Papai et al. generically encompass the use of SEHA hydroxylamine preservatives and Burns et al., Hashimoto et al. and Ishikawa et al. '697 specifically disclose them as hydroxylamine preservatives for color developing agents and CD-4 color developing agents in concentrates or replenishers as in Hashimoto et al. and Ishikawa et al., it would be obvious to one skilled in the art to use SEHA hydroxylamine preservatives as the called for hydroxylamine preservatives in Darmon et al. and Papai et al. One skilled in the art would be particularly motivated to use SEHA hydroxylamine derivatives as the antioxidants in color

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developing replenisher concentrates in Darmon et al. and Papai et al. in view of the disclosure in Ishikawa et al. that they are preferred in the art. One skilled in the art would further be motivated to use SEHA hydroxylamine preservatives as the antioxidants in the color developing replenisher concentrates of Darmon et al. and Papai instead of unsubstituted alkyl hydroxylamines as used in the working Examples in Darmon et al. and Papai in view of the disclosure in Marrese et al. (see particularly column 1, lines 34-60) that it is known to add water solubilizing groups, including sulfo, to alkyl hydroxylamine color developing agent antioxidants to reduce their release into the atmosphere as vapor, i.e. odor, by increasing the water solubility. One skilled in the art would be motivated to use sulfo substituted hydroxylamines, as known in the art as color developing agent preservatives as set forth in Burns et al., Ishikawa et al. and Hashimoto et al., instead of unsubstituted alkyl hydroxylamines as used in Darmon et al. and Papai in order to provide color development replenisher concentrates in Darmon and Papai wherein the hydroxylamine preservatives have increased water solubility and are not lost by release into the atmosphere by vaporization as much as unsubstituted alkyl hydroxylamines. The comparisons in the specification have been considered but are unconvincing for the reasons as set forth in the second paragraph

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of item No. 5 of the last Office action.

Applicant's arguments in regard to Darmon and Papai that Darmon and Papai do not disclose the specific combination of color developer CD-4 and antioxidant SEHA is unconvincing since Darmon et al. and Papai generically encompass the use of substituted hydroxylamine preservatives for color developing agents so that it would be obvious to one skilled in the art to use preferred hydroxylamine color developing agent preservatives, such as SEHA, as the called for hydroxylamine color developing agent preservatives for the known improved properties of SEHA. SEHA is a preferred hydroxylamine in Ishikawa et al. '697 as used in their working Examples and is the only hydroxylamine used in the working Examples of Hashimoto et al. out of all of the hydroxylamines disclosed in Hashimoto et al. Also Marrese et al. discloses that alkyl hydroxylamines with water solubilizing groups, including sulfo, would have less loss to the atmosphere due to their increased water solubility.

6. Claims 1-3, 5, 6, 16, 17 and 19 are rejected under 35 U.S.C. § 102(e) as being anticipated by Ishikawa et al. '697. Ishikawa et al. '697 (see particularly column 7, line 64 - column 8, line 64; column 9, lines 15-45; Examples 1 and 2) disclose color developing agent solutions and replenishers containing hydroxylamine preservatives wherein it is disclosed that SEHA is

a preferred hydroxylamine preservative. The color developing agents include CD-4. Working Examples 1 and 2 set forth color developing solutions and/or replenishers that have color developing agent CD-4 and SEHA.

7. Claims 3 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishikawa et al. '697. Ishikawa et al. '697 (see particularly column 7, line 64 - column 8, line 64; column 9, lines 15-45; Examples 1 and 2) disclose color developing agent solutions containing color developing agents, including CD-4 and hydroxylamine preservatives for the color developing agents including SEHA which is disclosed as preferred.

The color developing composition in Example 1 has SEHA and another hydroxylamine. It would at least be obvious to one skilled in the art to use the combination of preferred preservative SEHA and other disclosed hydroxylamines as preservatives in the color developing solutions of Ishikawa et al. '697 with color developing agent CD-4 which is disclosed as preferred and is used in working Examples 1 and 2.

8. Japanese Publication 8-137070 is cited of interest in the art as being equivalent to Ishikawa et al. '697.

9. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

Serial No. 10/071,293

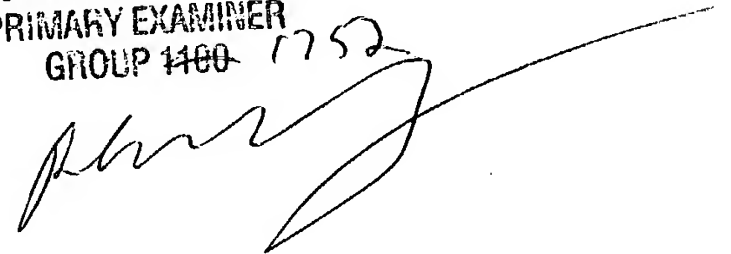
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RLSchilling:cdc

March 26, 2004

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP 1400 1752

A handwritten signature in black ink, appearing to read 'R. Schilling', is written over the printed name and title.